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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,614	05/08/2006	Nobuhiro Ishida	290578US0X PCT	3583
22850	7590	12/22/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
JOLKE, MICHELE K				
ART UNIT		PAPER NUMBER		
1636				
NOTIFICATION DATE		DELIVERY MODE		
12/22/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/578,614

Applicant(s)

ISHIDA ET AL.

Examiner

MICHELE K. JOIKE

Art Unit

1636

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 22-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 8/7/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I in the reply filed on September 22, 2008 is acknowledged.

Claims 22-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 22, 2008.

Claims 1-21 are examined.

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. The hyperlinks are on page 11.

Claim Objections

Claim 8 is objected to because of the following informalities: There should be a space between "in" and "organic" in line 2. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-9, 12-21 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/14335 (hereinafter Porro).

Porro (see entire reference, especially p. 4, lines 12-18, p. 5, lines 12-15, p. 10, lines 29-30, p. 12, lines 12-15, and claims 1, 19-21) teaches a gene encoding a bovine lactate dehydrogenase operably linked to a promoter. The LDH gene and promoter are on a plasmid that is transformed into *Saccharomyces*. The limitation is claim 1(c) allows for any promoter to be used. Porro teaches the use of many promoters, including ADH1 and PDC1. Porro also teaches integration of the LDH gene into a yeast chromosome. The LDH gene with the PDC1 promoter can be integrated. Porro teaches disruption of the PDC1 gene, which can be caused by integration.

Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Hauf et al.

Hauf et al (Enz. and Micro. Tech. 26: 688-698, 2000, especially p. 688 and materials and methods) teach using the HXT7 promoter for expression of glycolytic genes in *S. cerevisiae* in the presence of an organic acid.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porro as applied to claims 1-2, 4-9, 12-21 above, and further in view of US 20030228671 (hereinafter Hause).

Porro teaches all of the limitations as described above. However, it does not teach a DNA construct including DNA for homologous recombination of PDC1.

Hause (especially pp. 3, 4) teaches flanking the LDH gene with promoter and terminator sequences of PDC1 for homologous recombination and integration of LDH.

The ordinary skilled artisan, desiring to use a DNA construct including DNA for homologous recombination of PDC1, would have been motivated to combine the

teachings of Porro teaching a gene encoding a bovine lactate dehydrogenase operably linked to a PDC1 promoter, and integration of the LDH gene into a yeast chromosome, with the teachings of Hause teaching flanking the LDH gene with promoter and terminator sequences of PDC1 for homologous recombination and integration of LDH because Hause states that such recombinant yeast cells exhibit unexpectedly high yields of lactic acid from carbohydrate substrates, together with high productivities, when used in a fermentation process. It would have been obvious to one of ordinary skill in the art to use a DNA construct including DNA for homologous recombination of PDC1 because Porro teaches that cells with a disrupted PDC1 and an exogenous LDH gene, yield high levels of lactic acid. Given the teachings of the prior art and the level of the ordinary skilled artisan at the time of the applicant's invention, it must be considered, absent evidence to the contrary, that said skilled artisan would have had a reasonable expectation of success in practicing the claimed invention.

Allowable Subject Matter

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELE K. JOIKE whose telephone number is (571)272-5915. The examiner can normally be reached on M-F, 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571)272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michele K Joike/
Examiner, Art Unit 1636

Michele K Joike
Examiner
Art Unit 1636